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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/531,531 | 03/21/00 | SHIROTA | Y 257718 |

EXAMINER

QM02/0125

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2743 | 6 |

DATE MAILED: 01/25/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on Preliminary Amdt of 12-05-00 & 12/18/00.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –



★ U S GPO: 1996-409-290/40029

Applicants have filed two applications, SN 09/531,531 and 09/460,795 that appear to be virtually identical. A tracing of parentage shows a linear relationship as follows:

SN 08/531,383 abandoned

CIP

SN 08/731,792 (5,755,107)

DIV

SN 09/038,902 (6,004,656)

DIV

SN 09/460,795 (pending)– (abandoned)

CON

SN 09/531,531 (pending)

Are there any other child applications which depend for continuity on any of the above listed applications? If so, please provide serial numbers and relationships.

The Examiner needs publication dates for all Japanese priority documents being used to obtain 35 USC 119 priority. Applicant is required to provide a description of how SN 08/731,792 differs in disclosures from SN 08/531,383.

The Examiner requires full translations of the Japanese prior cited by applicant on the PTO-1449. The Examiner believes such translations are readily available to the real party in interest (Denso). Procuring them should present no financial hardship to a corporation with the resources of Denso. The examination requires a full understanding of these disclosure. A copy of

any Japanese search report or prosecution history that involved these references would also be helpful, if it is available.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,755,107. Although the conflicting claims are not identical, they are not patentably distinct from each other because see In re Goodman and the rationale explained there.

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,044,656. Although the conflicting claims are not identical, they are not patentably distinct from each other because see In re Goodman and the rationale explained there.

One of the references (JA 5-003,365) cited by applicants on the PTO-1449 form is incomplete and does not ~~apart~~ appear to correspond to what is translated. The Examiner will need a

complete copy of the reference that was translated (not the reference, incomplete, that was supplied with the translation).

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether an air conditioner per se is being claimed or an air conditioner in combination with the vehicle is being claimed. If it is the air conditioner per se then limitations such as 'at a center of the instrument panel" or in a "width direction" [of the vehicle] are ~~member~~ were matters of intended use, and will be given no patentable weight. On the other hand, if these are combination claims then the preamble should be amended to reflect the combination of a vehicle and air conditioning system and the vehicle should be explicitly recited after the word "comprising". It appears that a large part of the alleged novelty and non-obviousness involves where and how this device is installed in the vehicle.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JA 6-156049.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JA 6-156049 as applied to claims 1-14 above, and further in view of JA 0167318 or conceded prior art Figure 19 of the current application or Netherlands 166433(Fig 1).

JA '318 (fig. 3), Netherlands '433 and the conceded prior art of Figure 19 teach central mounting of the AC/heater unit to reduce the space taken up on the driver and passenger sides of the automobile interior (see Figs 2 of JA '318 showing the elongated type of prior art which took up lots of room and Fig. 17 of the current application). To have center mounted JA '049 to obtain this advantage would have been obvious.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1-14 above, and further in view of JA 56-82628 or JA 56-149819.

JA '049 shows all of the claimed features with the possible exception of the last paragraph of claim 1 (blower shifted off to the side).

JA '628 teaches a blower 2 shifted off to one side in a "width' direction of the vehicle, as does JA '819.

To have modified JA '049 with an offset blower such as taught by JA '628 or JA '819 to advantageously reduce the overall vertical height of the system show in JA '049 to permit it to fit

in vehicles with smaller spaces under the dashboard would have been obvious to one of ordinary skill in the art.

Claims 1-~~12~~ 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1-~~12~~ 14 above, and further in view of Bates (190144), Mullin (3000192), Brandecker (2552396), Gebhardt (2703223) or Martsteller (3492833).

Each of these references taken individually teach tubes oriented in the direction of the air flow in system where the flow from the blower is directed upwardly through a heat exchanger. Regarding claim 5 see Gebhardt drain 34 and its orientation relative to cooling heat exchanger 25 and blower 14.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to John Ford at telephone number (703) 308-2636.

John K. Ford
Primary Examiner

J. FORD:LM
JANUARY 12, 2001